

REMARKS

In the Office Action the Examiner noted that claims 1-26 are pending in the application, and the Examiner rejected all claims. By this Amendment, claim 8 has been cancelled without prejudice or disclaimer, and claims 1-7, 9-11, 20-22, and 25-26 have been amended. No new matter has been presented. Thus, claims 1-7 and 9-26 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Claim Rejections Under 35 USC §101

In item 4 on pages 2-3 of the Office Action the Examiner rejected claims 25 and 26 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In particular, the Examiner concluded that a signal "is considered non-statutory because it is a form of energy, in the absence of any physical structure or tangible material, that does not fall within any of the four statutory classes of 35 U.S.C. § 101."

The Applicants respectfully submit that the USPTO's Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility specifically indicate that they do not constitute substantive rulemaking and do not have the force and effect of law. Rather, the Guidelines have been designed to assist USPTO personnel in analyzing claimed subject matter for compliance with substantive law. As the Guidelines also state, rejections should be based on substantive law. See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, section I.

The Applicants further submit that in Appeal No. 2,002-1554, in the case of Ex parte Rice (Application 08/003,996), the Board of Patent Appeals and Interferences reversed an examiner's rejection of signal claims as being directed to non-statutory subject matter under 35 U.S.C. § 101, holding that electromagnetic signals, although "transitory and ephemeral in nature," are statutory subject matter..

Further, the Manual of Patent Examining Procedure (MPEP) clearly states that a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature. See MPEP, section 2106, IV(B)(1)(c). *See also O'Reilly*, 56 U.S. at 114-19; *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980).

Moreover, the Applicants respectfully submit that claims 25 and 26 recite, "a computer data signal embodied in a carrier wave. . . to control a processor to perform a method."

Therefore, the claim clearly performs a useful, concrete, and tangible result, that is, controlling a processor to perform the recited operation.

In light of the foregoing, the Applicants respectfully request that the rejection be withdrawn.

Claim Rejections Under 35 USC §102

In item 6 on pages 4-8 of the Office Action the Examiner rejected claims 1, 3-4, 6-7, 20, 22, 24, and 26 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,938,727, issued to Ikeda (hereinafter referred to as "Ikeda"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Ikeda discloses a configuration in which a telephone number, a facsimile number, a URL of a homepage, or an email address is recorded in a barcode or in a two-dimensional code, the barcode or the two-dimensional code is affixed onto a business card, an advertisement on a newspaper, or the like, a PC of a consumer side reads out the barcode, or the two-dimensional code, and the PC then conducts the transmission. In other words, the two-dimensional barcode basically includes four kinds of individual identification information (Column 6, Lines 32-34).

This is in direct contrast with claim 1 of the present application, as amended, which recites converting conveyance information into pattern information, the conveyance information including "at least one of provision information that the information provider side provides to the consumer side, return information for returning the reply information, and a storage program determining an environment surrounding the consumer side." Embodiments of the present claimed invention may represent, as pattern information, conveyance information such as moving or still images, audio data, a transmission destination of information sent by the consumer, a program for identifying the consumer's environment and/or a conveyance method used by the consumer and/or a terminal on the consumer side, and so on (see line 20 of page 7 through line 4 of page 8 of the present application). In other words, the information recorded in the two-dimensional code of the present claimed invention corresponds to sending and receiving various types of information, which is altogether different that Ikeda, which merely deals with providing various types of addresses.

While the Examiner has cited Column 4, Line 29 through Column 5, Line 19 of Ikeda as disclosing similar features to these features of claim 1, the cited sections merely disclose the basic concept of scanning a newspaper or magazine section to receive a URL, and has no

anticipation or suggestion of the discussed features. As Ikeda does not disclose or suggest providing other than basic identification information for inputting URL's, email addresses, etc., to aid in contacting those destinations, it is respectfully submitted that Ikeda does not disclose or suggest all of the features of claim 1 of the present application. Therefore, the Applicants respectfully submit that claim 1 patentably distinguishes over Ikeda, and further request that the Examiner withdraw the §102 rejections.

Claims 3-4, 6-7, 20, 22, 24, and 26 all recite similar features as claim 1 regarding the content of the conveyance information. Therefore, the Applicants respectfully submit that these independent claims also patentably distinguish over Ikeda.

Claim Rejections Under 35 USC §103

In item 8 on pages 8-17 of the Office Action the Examiner rejected claims 2, 5, 7-19, 21, 23, and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,845,388, issued to Philyaw (hereinafter referred to as "Philyaw") in view of Ikeda. Claim 8 of the present application has been cancelled without prejudice or disclaimer. The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

Independent claims 2, 5, 7, 21, and 25 all include similar features to those discussed in regard to claim 1. As discussed in the previous section of this Amendment, Ikeda fails to disclose or suggest these features. Further, Philyaw fails to cure the deficiencies of Ikeda regarding these discussed features. In the Examiner's arguments regarding claim 8 on page 12 of the Office Action, the Examiner cited sections of Philyaw as disclosing these features. However, these sections of Philyaw apparently merely disclose a method of gaining a URL from a scanned barcode, which is substantially similar to the method disclosed in Ikeda. Therefore, as neither of the cited references, either alone or in combination, disclose or suggest all of the features of independent claims 2, 5, 7, 21, and 25, it is respectfully submitted that claims 2, 5, 7, 21, and 25 patentably distinguish over the cited references.

Claims 8-19 depend from claim 7 and include all of the features of that claim plus additional features which are not disclosed or suggested by the cited references. Also, claim 23 depends from claim 21 and includes all of the features of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claims 8-19 and 23 also patentably distinguish over the cited references.

Summary

In accordance with the foregoing, claim 8 has been cancelled without prejudice or disclaimer, and claims 1-7, 20-22, and 25-26 have been amended. No new matter has been presented. Thus, claims 1-7 and 9-26 remain pending in the application.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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